

**REMARKS**

The Office Action mailed March 20, 2006, has been carefully considered. The present Amendment is intended to be a complete response thereto and to place the case in condition for allowance.

Claims 1, 3-10, and 12 are pending. Claims 1 and 10 have been amended to include all the limitations of claims 2 and 11, respectively. Claims 2 and 11 have been cancelled.

**THE CLAIMS ARE NOT ANTICIPATED**

Claim 1, 3-5, 9, 10, and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Akasaka (U.S. Patent No. 5,426,621). Applicants respectfully submit that the rejection is moot because independent claims 1 and 10 have been amended to include all the limitations of original claims 2 and 11, respectively, which are not included in this rejection.

**THE CLAIMS ARE NOT OBVIOUS**

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being obvious over Akasaka. Claim 1, 2, 8, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as being obvious over O'hara in view of Akasaka. Applicant respectfully traverses the rejections.

To anticipate a claim, the reference must teach every element of the claim. *See* MPEP § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The

identical invention must be shown in as complete detail as is contained in the ... claim."

*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

First, the cited references, taken alone or in combination, fail to disclose every element of the claimed invention. In particular, the references fail to disclose that the "luminous elements are lodged in blind hollows made in said semi-transparent layer and open towards said substrate plate" as recited in independent claims 1 and 10.

O'Hara discloses a method for protecting luminous radium (3) on an article (1) by coating the radium (3) with a coat of flux powder and firing or vitrifying the flux coating, which results in a transparent, hard glazed coat (4).

Akasaka discloses a luminous dial plated containing a metal lower plate (2) having recesses (11) which are filled with luminous agents (6). The lower plate (2) and recesses (11) are covered by lacquer (7). A upper member (3), made of translucent frosted glass, is bonded to the top of the lacquer (7). *See* Figure 3; and column 4, lines 26-47.

Thus, neither of the references disclose blind hollows in the semi-transparent layer. O'Hara, as admitted by the Examiner on page 5 of the Office Action, fails to disclose a semi-transparent layer altogether.

Akasaka discloses a translucent upper member (3), but fails to disclose that the translucent upper member (3) has blind hollows that contains the luminescent agents (6). Moreover, on the contrary, Akasaka discloses recesses (11) in the lower plate (2), not the upper member (3), to contain the luminescent agents (6). There are no modification in the upper member (3) of Akasaka to accommodate the luminescent agents (6). Though the Examiner states on page 6 of the Office Action that "Akasaka teaches that a semi-transparent upper layer

..., wherein said luminous elements are lodged in blind holes made in said transparent layer and open towards said plate,” there is no support for that statement.

Second, there is no motivation to combine the references. Contrary to the Examiner’s contention, one of ordinary skill in the art would not have replaced the transparent coat (4) of O’Hara with the translucent upper member (3) of Akasaka because O’Hara specifically teaches that his coating protects the luminous radium better than other methods of covering such as sheets of glass or mica, or lacquer or varnish (see column 1, lines 31-55). O’Hara specifically discloses that the transparent coating is superior to the other coating methods by permitting

the light emanating from the radium luminous material to pass through the coating in substantially its full strength and which shall protect the radium luminous material against disintegration and render it weather proof and of such character that it will not readily collect dust and dirt, and which can be easily cleaned without detriment to the radium luminous surface or to the protective coating.

See column 1, lines 43-55. O’Hara’s invention, therefore, relies on the specific nature of his transparent coating. On the other hand, Akasaka teaches upper member (3) made of translucent frosted glass (see column 4, lines 44-47), Japanese paper, fabric, or wood hardened with a synthetic resin (see column 4, lines 11-14). By reading O’Hara, one of ordinary skill in the art would not have replace the transparent coating of O’Hara with the translucent upper layer of Akasaka, because doing so would render the O’Hara reference unsatisfactory for its intended purpose. MPEP 2143.01(V). Here, using the translucent upper layer of Akasaka would defeat the advantages of O’Hara’s transparent coating.

Further, O’Hara also teaches away from the use of glass, mica, lacquer, or varnish (see column 1, lines 31-42). Therefore, one of ordinary skill in the art would not have been motivated

to use the translucent frosted glass or lacquer of Akasaka in the article of O'Hara, because this would be contrary to the teaching of O'Hara.

Therefore, for the foregoing reasons, O'Hara and Akasaka, taken alone or in combination, fail to render the present invention obvious. Accordingly, Applicants respectfully request the withdrawal of the rejection.

#### CONCLUSION

Applicant has responded to the Office Action mailed March 20, 2006. All pending claims are now believed to be allowable and favorable action is respectfully requested.

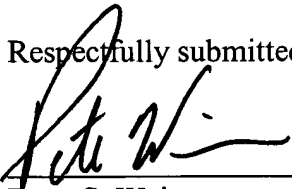
In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (116598-00114). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time. Any fees due are authorized above.

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Respectfully submitted,

  
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